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In re Application of
IBRAHIM, Nicolas
U.S. Application No.: 10/553,535
PCT No.: PCT/FR2004/000958
Int. Filing Date: 16 April 2004
Priority Date: 17 April 2003
Attorney Docket No.: W51-12-0022
For: RADIO DATA TRANSMISSION
METHOD, EMPLOYING SEVERAL
DIFFERENT PILOT PATTERNS, . . .

DECISION

This decision is in response to the petition under 37 CFR 1.47(b) filed with the United States Designated/Elected Office (DO/EO/US) on 13 December 2006.

BACKGROUND

On 14 August 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. Applicant was given two months to respond with extensions of time available.

On 14 December 2006, applicant filed the subject petition which was accompanied by, *inter alia*, a two-month extension and fee; the petition fee; the surcharge fee; a declaration signed by the 37 CFR 1.47(b) applicant for the nonsigning inventor; and other assorted documentary evidence.

DISCUSSION

The 37 CFR 1.47(b) applicant claims that the sole inventor in the above-captioned application refuses to cooperate and filed a petition pursuant to 37 CFR 1.47(b) as a response to the Form PCT/DO/EO/905 mailed 14 August 2006.

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of the nonsigning joint inventor (5) evidence showing sufficient proprietary interest in the application; and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Concerning item (1), the petition fee is now \$200.00. The \$70.00 difference has been charged to Deposit Account No. 23-1123 as authorized.

Regarding item (2), the 37 CFR 1.47(a) applicant claims that the sole inventor refuses to join in the application. Petitioner states that a complete copy of the application, declaration and assignment were presented to the nonsigning inventor on 17 July 2006. A copy of an assignment and declaration were previously mailed on 22 December 2005. The 37 CFR 1.47(a) applicant provided copies of these documents along with an English translation of the cover letters. Proof of delivery of the documents was also submitted. An unsigned statement by Patrice Vidon, a French patent attorney was submitted and it states that "Nicolas Ibrahim failed to respond in any manner." This is sufficient to meet the requirements of section 409.03(d) of the MPEP. As such, item (2) of 37 CFR 1.47(b) is complete.

With regards to item (3), the last known address of the nonsigning joint inventor, Nicolas Ibrahim Jung is given as:

1, rue Bleuats
78180 Montigny le Bretonneux
France

Concerning item (4), the 37 CFR 1.47(b) applicant submitted an unexecuted declaration and power of attorney listing the name address and citizenship of the nonsigning inventor. Petitioner also provided an "Added Page to Combined Declaration and Power of Attorney . . ." on behalf of the nonsigning inventor signed by Mr. Pierre Cosnier as Legal Director of Wavecom. Mr. Cosnier states on the supplemental declaration that he is authorized to act on behalf of Wavecom. See § 324 MPEP. The declaration meets the requirements of section 409.03(b) of the MPEP. Thus, item (4) is complete.

Regarding item (6), the 37 CFR 1.47(b) applicant provided a statement that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Items (1), (2), (3), (4) and (6) of 37 CFR 1.47(b) are complete.

With regards to item (5), petitioner claims sufficient proprietary interest in the above-captioned application by way of an employment agreement signed by Mr. Ibrahim. Section 409.03(f) of the MPEP discusses proof of proprietary interest and states, in part:

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent

on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

Here, petitioner has provided a copy of an employment agreement signed by Mr. Ibrahim. A review of the employment agreement indicates that paragraph 8 provides the employer with rights of any invention made, including rights abroad. Petitioner also submitted a statement that "Mr. Ibrahim was employed by Wavecom at the time the invention was made and remained employed at Wavecom through the time the original priority patent application was filed on April 17, 2003."

However, the statement was unsigned and it is not clear if it was made by a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant. This is an absolute requirement when meeting the propriety interest requirement using an employment agreement. For this reason, item (5) is not yet satisfied.

CONCLUSION

For the reason discussed above, applicant's petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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